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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,577	03/02/2004	Hans-Ullrich Huth	2003DE413	3087

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Clariant Corporation  
Industrial Property Department  
4000 Monroe Road  
Charlotte, NC 28205

EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/791,577	Applicant(s) HUTH ET AL.	
	Examiner Judy M. Reddick	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 7,8 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 9-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

**Election/Restrictions**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6 and 8-15, drawn to a polymeric composition, classified in class 524, subclass 27.
  - II. Claims 7 and 16, drawn to a water-insoluble capsule or film, classified in class 424, subclass 451.
2. The inventions are distinct, each from the other because:
3. Inventions Group I and Group II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a hydrogel-containing skin adhesive and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. The intermediate product(Group I) is in mutually exclusive relationship with the final product(Group II) as per presumably a reaction taking place upon formation of the capsule or film engendering a final product structurally distinct from the intermediate product, i.e., the intermediate product loses its identity upon formation of the final product. Moreover, Applicant, himself, has identified two distinct uses of the polymeric composition(claims 7 and 16) and therefore substantiates the Examiner's position.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. This application contains claims directed to the following patentably distinct species of the claimed invention: a) the instant Polyvinyl alcohol component which includes modified (claim 8) and unmodified (claims 1 and 15) and b) the instant polysaccharide (claims 1 and 15 b).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed ultimate species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-16 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. During a telephone conversation with Mr. Silverman on 07/15/04 a provisional election was made with traverse to prosecute the invention of Group I/species of Example 1, claims 1-6, & 9-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7, 8 and 16 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### Priority

9. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### Specification

10. The abstract of the disclosure is objected to because of its length(in excess of 150 words/characters) and format(in excess of 1 paragraph). Correction is required. See MPEP § 608.01(b).

11. The use of the trademark Lamepon S (Spinnrad) @ page 5, Examples 2 & 4 has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The relationship between a trademark and the product it identifies is sometimes indefinite, uncertain and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. In patent specifications, every element or ingredient of the product should be set forth in positive, exact, intelligible

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language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to mean different things at the pleasure of manufacturers do not constitute such language. *Ex Parte Kattwinkle*, 12 USPQ 11 (Bd. Apps. 1931). Identification of the trademarks may be introduced by amendment but it must be restricted to the characteristics of the product known at the time the application was filed to avoid any question of new matter. See M.P.E.P ' 608.01(v).

**Claim Rejections - 35 USC § 112**

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 1-6 and 9-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) The recited "substantively composed of" per claim 1 constitutes indefinite subject matter because the term "substantively" in the claim is a relative and not absolute term. The term "substantively" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

B) The recited contents governing "polyvinyl alcohol"(1 & 15), "polysaccharides"(1, 9, 10 & 15), "antifoam"(2), "surface-active compound"(3), "hydrophobicizing oils"(4), "modifiers or antiflow additives"(5), "plasticizer"(6) constitute indefinite subject matter as per it not being readily ascertainable as to the exact entity that the contents are being based upon, i.e., total composition, a) and/or b) or else.

C) The recited "average molecular weight" per claims 1 & 15 constitutes indefinite subject matter as per it not being readily ascertainable if "weight average" or "number average" is intended, the two being substantially different.

D) The moiety "COOMe" per claims 1 and 15 is recited in duplicate.

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E) The recited "R6 is "C1-C4" per claims 1 and 15 constitute indefinite subject matter as per the radical qualified by the "C1-C4" is not readily ascertainable.

**Claim Rejections - 35 USC § 102**

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-6 and 9-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Takizawa et al(U.S. 4,777,089) or Takizawa et al(U.S. 4,908,233).

Each of Takizawa et al teach hydrous compositions-containing microcapsules. In particular, each of Takizawa et al teach microcapsule-containing hydrous compositions comprising (i) 5 to 80 wt. % of an electrolyte which includes (in)organic salts and (ii) microcapsules composed of a core material coated with a water-soluble polymer. More specifically, each of Takizawa et al teach a capsule core material dispersed in an aqueous solution containing a first water-soluble polymer such as polyvinyl alcohol, governed by a degree of hydrolysis of at least 50 mol % and 0.005 % by weight to 20 % by weight of a second water-soluble polymer such as gum Arabic, alginic acid salts, pectin, etc. and a process for producing said microcapsules which basically involves dispersing a capsule core material, substantially insoluble in water, in an aqueous solution

containing a first water-soluble polymer, capable of undergoing phase separation, and incorporating an aqueous salt solution of a second water-soluble polymer, capable of causing phase separation, thereto (Abstract, col. 1, lines 5-15, col. 2, lines 26-59 & cols. 4-7 of Takizawa et al'089 and the Abstract, col. 1, lines 7-16, col. 2, lines 28-61, col. 3, lines 11-50 and cols. 4-7 of Takizawa et al'233. More specifically, each of Takizawa et al exemplify formulations containing at least a polyvinyl alcohol governed by a degree of hydrolysis(saponification) of 87 to 89 mole % and a degree of polymerization of about 500 which appears to overlap in scope with the claimed polyvinyl alcohol component and a polysaccharide which includes pectin and appears to overlap in scope with the claimed polysaccharide (Run 15 of each of Takizawa et al). Each of Takizawa et al therefore anticipate the instantly claimed invention with the understanding that the compositions of each of Takizawa et al overlap in scope with the claimed composition.

Even if it turns out that the claims are not anticipated, it would have been obvious to the skilled artisan to extrapolate the polymeric composition, as claimed, from the disclosures of Takizawa et al as per such having been within the general purview of the disclosures of patentees and with a reasonable expectation of success. As to the molecular weight limitation per claims 1 & 15, if not anticipated by the Runs of Takizawa, one of ordinary skill in the art would recognize such molecular weights as conventional and obvious to employ, absent a showing of criticality for the specific molecular weights claimed.

As to any remaining dependent claim limitations, if not taught or suggested, these limitations would have been obvious to the skilled artisan and with a reasonable expectation of success, i.e., any additional or particular claim parameters which may not be specifically set out in the references are considered to be inherent in the reference products or not to involve anything unobvious absent a showing to the contrary.



17. Claims 1-6 and 9-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Roreger et al(U.S. 5,456,745).

Roreger et al teach flexible, hydrophilic, water-insoluble gel films that are defined basically as containing (a) 0.5 to 30 wt. % of at least one water-soluble polymer being anion-active at neutral pH which includes anionic polysaccharides such as pectins, carrageenanes, alginates, etc., (b) 0.5 to 50 wt. % of at least one water-soluble polymer being cation-active at neutral pH, (c) at least one moisturizer, (d) 0.1 to 70 wt. % of water, (e) 0 to 50 wt. % of water-soluble or water-dispersible auxiliaries which include softeners, foam stabilizers, thickeners such as polyvinyl alcohol, etc. and (f) 0 to 50 wt. % of active substance(Abstract, col. 2, lines 19-67, col. 3, lines 53-67, col. 4, lines 1-67, col. 5, lines 1-13). Roreger et al exemplify compositions containing at least NV-pectin and polyvinyl alcohol(Mowiol 10-98). Roreger et al therefore anticipate the instantly claimed invention with the understanding that the film of Roreger et al overlaps in scope with the claimed polymeric composition.

Even if it turns out that the claims are not anticipated, it would have been obvious to the skilled artisan to extrapolate, from Roreger et al, the polymeric composition, as claimed, as per such having been within the purview of the general disclosure of Roreger et al and with a reasonable expectation of success. Moreover, in terms of the molecular weight of the polyvinyl alcohol component per claims 1 & 15, if not anticipated by the Runs of Roreger et al, one of ordinary skill in the art would recognize such molecular weights as conventional and obvious to employ, absent a showing of criticality for the specific molecular weights claimed.

As to any remaining dependent claim limitations, if not taught or suggested, these limitations would have been obvious to the skilled artisan and with a reasonable expectation of success, i.e., any additional or particular claim parameters which may not be specifically set out in the references are considered to be inherent in the reference products or not to involve anything unobvious absent a showing to the contrary.


**Conclusion**

18. The additional prior art listed on the attached FORM PTO 892 is cited as of being illustrative of the general state of the art.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571)272-1110. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR *JMR*  
07/26/04